

REMARKS

Claims 9 to 20 are added, and therefore claims 5 to 20 are now pending.

In paragraph three (3) of the Office Action, claims 5 and 6 were rejected under 35 U.S.C. § 102(e) as anticipated by Janky et al., U.S. Patent No. 6,067,031 ("Janky").

As regards the anticipation rejections of the claims, to reject a claim under 35 U.S.C. § 102(b), the Office must demonstrate that each and every claim limitation is identically described or contained in a single prior art reference. (*See Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)).

Independent claim 5 recites a device for controlling distance for a motor vehicle that includes, at least one sensor for recognizing a poor visibility condition, the at least one sensor including at least one sensor for detecting a road condition and at least one sensor for detecting a level of brightness and adapted to recognize darkness. While the Office Action suggests that Janky discloses both a road condition sensor and a brightness sensor, it is respectfully submitted that Janky does not in fact identically disclose each of these features.

The Janky reference refers to an apparatus for monitoring road conditions. (*See Janky*, col. 16, lines 48 to 49). It is stated that this apparatus employs a light beam that is directed at an angle with respect to the road that is substantially greater than zero but substantially less than 90 degrees. *Id.* at lines 54-57. In other words, the light beam is directed at an angle intermediate between straight downwards and parallel to the road in order to view road conditions. Light reflected from the light beam is detected using a light sensor (171). *Id.* at lines 60 to 62.

It is subsequently stated that "[i]f heavy fog or another visibility-reducing atmosphere is present, the light sensor 171 may sense a sharply reduced intensity of the reflected light beam, or no intensity at all." Janky, col. 17, lines 11 to 13. From this passage, it can be seen that Janky is using the same light sensor to determine both road conditions and brightness in contrast to the claimed subject matter, which includes at least one sensor for detecting road conditions and at least one sensor for detecting brightness.

The claimed subject matter clearly contemplates the simultaneous use of both types of sensors where it provides (in an exemplary embodiment) eight sensors, S1 to S8, five of which (S1 to S5) detect weather and road conditions, and three of which (S6 to S8) measure brightness. The use of distinct sets of sensor is significant at least because the claimed

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subject matter does not rely on a single sensor (which may malfunction) to determine visibility conditions, but rather relies on different sets of sensors particularly adapted to serving specific functions, making the resulting determinations more robust and reliable.

For at least these reasons, it is respectfully submitted that Janky does not identically disclose (or even suggest) each of the features of claim 5 or of dependent claim 6, which are therefore allowable.

With respect to paragraph five (5) of the Office Action, claims 7 and 8 were rejected under 35 U.S.C. § 103(a) as unpatentable over the Janky reference.

Since claims 7 and 8 depend from claim 5, and the Janky reference does not disclose or suggest all of the features of claim 5, as discussed above, it is respectfully submitted that claims 7 and 8 are also allowable over the Janky reference.

As further regards the obviousness rejection, to reject a claim as obvious under 35 U.S.C. § 103, the prior art must disclose or suggest each claim element and it must also provide a motivation or suggestion for combining the elements in the manner contemplated by the claim. (See Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934 (Fed. Cir. 1990), cert. denied, 111 S. Ct. 296 (1990); In re Bond, 910 F.2d 831, 834 (Fed. Cir. 1990)). Thus, the “problem confronted by the inventor must be considered in determining whether it would have been obvious to combine the references in order to solve the problem”, Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 679 (Fed. Cir. 1998), which as referred to above simply do not address the problems met by the subject matter of any of the rejected claims.

The cases of In re Fine, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988), and In re Jones, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992), also make plain that the Office Action’s assertions that it would have been obvious to modify the reference relied upon does not properly support a § 103 rejection. It is respectfully suggested that those cases make plain that the Office Action reflects a subjective “obvious to try” standard, and therefore does not reflect the proper evidence to support an obviousness rejection based on the references relied upon. In particular, the Court in the case of In re Fine stated that:

Instead, the Examiner relies on hindsight in reaching his obviousness determination. . . . **One cannot use hindsight reconstruction to pick and choose among isolated**

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disclosures in the prior art to deprecate the claimed invention.

In re Fine, 5 U.S.P.Q.2d at 1600 (citations omitted; emphasis added). Likewise, the Court in the case of In re Jones stated that:

Before the PTO may combine the disclosures of two or more prior art references in order to establish *prima facie* obviousness, there must be some suggestion for doing so, found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. . . .

Conspicuously missing from this record is any evidence, other than the PTO's speculation (if it be called evidence) that one of ordinary skill . . . would have been motivated to make the modifications . . . necessary to arrive at the claimed [invention].

In re Jones, 21 U.S.P.Q.2d at 1943 & 1944 (citations omitted; italics in original).

That is exactly the case here since it is believed and respectfully submitted that the Office Action reflects hindsight, reconstruction and speculation, which these cases have indicated does not constitute evidence that will support a proper obviousness finding.

More recently, the Federal Circuit in the case of In re Kotzab has made plain that even if a claim concerns a “technologically simple concept” -- which is not even the case here, there still must be some finding as to the “specific understanding or principle within the knowledge of a skilled artisan” that would motivate a person having no knowledge of the claimed subject matter to “make the combination in the manner claimed”, stating that:

In this case, the Examiner and the Board fell into the hindsight trap. The idea of a single sensor controlling multiple valves, as opposed to multiple sensors controlling multiple valves, is a technologically simple concept. *With this simple concept in mind, the Patent and Trademark Office found prior art statements that in the abstract appeared to suggest the claimed limitation. But, there was no finding as to the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of Kotzab's invention to make the combination in the manner claimed.* In light of our holding of the absence of a motivation to combine the teachings in Evans, we conclude that the Board did not make out a proper *prima facie* case of obviousness in

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rejecting [the] claims . . . under 35 U.S.C. Section 103(a) over
Evans.

(See In re Kotzab, 55 U.S.P.Q.2d 1313, 1318 (Federal Circuit 2000) (*italics added*)). Here again, there have been no such findings to establish that the features discussed above of the rejected claims are met by the references relied upon. As referred to above, any review of the references, whether taken alone or combined, makes plain that they simply do not describe the features discussed above of the rejected claims.

New claims 9 to 20 do not add any new matter and are suggested in the specification. New claims 9 to 20 depend from claim 5 and further recite features that are not disclosed or suggested by the Janky reference. These claims are allowable at least for the same reasons as claim 5.

In summary, it is respectfully submitted that all of claims 5 to 20 of the present application are allowable at least for the foregoing reasons.

CONCLUSION

In view of the foregoing, it is believed that the rejections have been obviated, and that claims 5 to 20 are allowable. It is therefore respectfully requested that the rejections be withdrawn, and that the present application issue as early as possible.

Respectfully submitted,
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